

REMARKS

In the Final Office Action¹ mailed March 3, 2010, the Examiner rejected claims 1-6, 8-12, 17, 20, 22-29, 31-35, 40, 43, 45-52, 54-58, 63, 66, 68-75, 77-81, 86, 89, 91, and 92 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,774,554 (“*Gilham*”) in view of U.S. Patent No. 6,772,130 (“*Karbowski*”); rejected claims 7, 19, 30, 42, 53, 65, 76, and 88 under 35 U.S.C. § 103(a) as being unpatentable over *Gilham* and *Karbowski* and in further view of U.S. Patent No. 6,385,504 (“*Pintsov*”); and rejected claims 13-16, 18, 21, 36-39, 41, 44, 59-62, 64, 67, 82-85, 87, and 90 under 35 U.S.C. § 103(a) as being unpatentable over *Gilham* in view of *Karbowski*, and in further view of Official Notice.

By this response, Applicant has amended claims 1, 17-21, 24, 40-44, 47, 63-67, 70, and 86-90. No new matter has been added as the amendments are supported at paragraphs 57 and 58 of the specification, among other places. Claims 1-92 remain pending and under examination.

Rejection of Claims 1-92 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 1-92 under 35 U.S.C. § 103(a) as being unpatentable over *Gilham* in view of *Karbowski* or over *Gilham* and *Karbowski* in further view of *Pintsov* or Official Notice. A *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. ... [R]ejections on

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action.

obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences *themselves* would have been obvious, but whether the claimed invention *as a whole* would have been obvious.” M.P.E.P. § 2141.02(I) (emphasizes in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). … The factual inquiries … [include determining the scope and content of the prior art and] … [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

A *prima facie* case of obviousness has not been established at least because the cited references and Official Notice fail to teach or suggest all the elements of independent claim 1, as amended. Amended claim 1 recites, among other things, “obtaining, using the computer system, data from the item, wherein the data is distinct from the verification data,” “obtaining, using the computer system, data from a verification database using the verification data as an index, wherein the data is distinct

from the verification data;" and "comparing, using the computer system, the data obtained from the item to the data obtained from the verification database."

Gilham fails to disclose or suggest at least these elements of amended claim 1. Instead, *Gilham* discloses that a transaction identifier that is obtained from a mail item is checked against a transaction identifier for the mail item that is stored in a database. *Gilham*, col.5:47-49. Because the Final Office Action alleges that the transaction identifier of *Gilham* is "verification data" (O.A. at 2), this same transaction identifier cannot be "data from the item, wherein the data is distinct from the verification data." Therefore, the transaction identifier of *Gilham* fails to disclose or suggest "obtaining ... data from the item, wherein the data is distinct from the verification data," as recited by amended claim 1.

Gilham also discloses that a license number is read from the mail item. *Gilham*, col. 5:42-44. However, the license number is not compared to "data obtained using a verification database." Indeed, the license number of *Gilham* is not compared to anything. Rather, the license number is used as an index to obtain data from a database. *Id.* For at least these reasons, *Gilham* fails to disclose or suggest "obtaining, using the computer system, data from the item, wherein the data is distinct from the verification data," "obtaining, using the computer system, data from a verification database using the verification data as an index, wherein the data is distinct from the verification data;" and "comparing, using the computer system, the data obtained from the item to the data obtained from the verification database," as recited by amended claim 1.

Karbowski fails to cure the defects of *Gilham*. The Final Office Action does not allege that *Karbowski* discloses these elements of claim 1. The Final Office Action cited *Karbowski* for allegedly disclosing “collecting electronic notification information from a sender,” “updating the verification database with a time or location of the item in the item delivery system,” and “using the electronic notification information to electronically transmit to the sender a notice containing the time or the location of the item in the item delivery system.” O.A. at 3. Applicant has carefully considered the scope and content of *Karbowski* and found that it fails to disclose or suggest “obtaining, using the computer system, data from the item, wherein the data is distinct from the verification data” and “obtaining, using the computer system, data from a verification database using the verification data as an index, wherein the data is distinct from the verification data;” and “comparing, using the computer system, the data obtained from the item to the data obtained from the verification database,” or anything similar in concept.

Pintsov also fails to teach or suggest the above-recited elements of amended claim 1. *Pintsov* discloses printing a unique mail piece identifier on a mail piece that is part of a batch of mail. *Pintsov*, col. 3:42-45. The unique mail piece identifier is comprised of the mailer’s identification number, the mail piece count, and the number of characters in the address. *Pintsov*, col. 11:3-6. *Pintsov* also discloses that the number of characters in the address in the unique identifier may be compared to the address field of the mail item. *Pintsov*, col. 13:26-30. However, the number of characters from the unique identifier of *Pintsov* are not “data in a verification database indexed by the verification data.” Rather, the number of characters from the unique identifier of *Pintsov* are part of the unique identifier, which is the verification data itself. Moreover, because

Pintsov does not disclose or suggest that these characters are read from a database, they cannot be “data obtained using a verification database.” For at least these reasons, *Pintsov* fails to disclose or suggest “obtaining, using the computer system, data from the item, wherein the data is distinct from the verification data” and “obtaining, using the computer system, data from a verification database using the verification data as an index, wherein the data is distinct from the verification data;” and “comparing, using the computer system, the data obtained from the item to the data obtained from the verification database,” as recited by amended claim 1.

Official Notice also fails to compensate for the deficiencies of *Gilham, Karbowski*, and *Pintsov*. Indeed, the Final Office Action does not allege that Official Notice discloses or suggests these elements of claim 1. Official Notice of facts beyond the record must be supported by reasoning. M.P.E.P. § 2144.03(B). No such reasoning with regard to “obtaining, using the computer system, data from the item, wherein the data is distinct from the verification data” and “obtaining, using the computer system, data from a verification database using the verification data as an index, wherein the data is distinct from the verification data;” and “comparing, using the computer system, the data obtained from the item to the data obtained from the verification database” was presented in the Final Office Action. In fact, because these elements are not capable of instant and unquestionable demonstration, Official Notice would be inappropriate. See, M.P.E.P. § 2144.03(A).

For at least the foregoing reasons, the cited references, taken alone or in combination, fail to teach or suggest all the elements of independent claim 1, as amended. In addition, there are significant differences and gaps between the teachings

of the cited references and the invention of claim 1, as a whole, that are so great as to render claim 1 nonobvious to one reasonably skilled in the art. M.P.E.P. § 2141. Thus, no reason has been clearly articulated as to why amended claim 1 would have been obvious to one of ordinary skill in the art in view of the cited prior art. Accordingly, the Final Office Action does not establish a *prima facie* case of obviousness with respect to amended independent claim 1, claim 1 is allowable over the cited references, and Applicant respectfully requests that the Examiner withdraw the rejection of claim 1 under 35 U.S.C. § 103(a).

Amended independent claims 24, 47, and 70, although different in scope, contain similar recitations as those discussed above regarding amended claim 1. For at least the reasons discussed above with regard to claim 1, the Final Office Action does not establish a *prima facie* case of obviousness with respect to amended independent claims 24, 47, and 70, these independent claims are allowable, and Applicant respectfully requests the Examiner withdraw the section 103 rejections of these claims.

Furthermore, because a *prima facie* case of obviousness has not been made for independent claims 1, 24, 47, and 70, a *prima facie* case of obviousness has also not been established for claims 2-23, 25-46, 48-69, and 71-92, by virtue of their dependence on the independent claims. Thus, dependent claims 2-23, 25-46, 48-69, and 71-92 are allowable at least by virtue of their dependence from allowable independent claims, as well as by reason of reciting additional elements not taught or suggested by the cited references. Accordingly, Applicant respectfully requests the Examiner withdraw the rejection of claims 1-92 under 35 U.S.C. § 103(a) and allow the pending claims.

CONCLUSION

If the Examiner believes that a conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicant's undersigned attorney at (571) 203-2430.

Please grant any extensions of time required to enter this Response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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